

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

## UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

JAN 13 2006

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ROSS MILLER

Appeal No. 2005-2188  
Application No. 09/751,577

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (mailed August 20, 2002) of claims 1 to 38, which are all of the claims pending in this application.

We REVERSE.

### BACKGROUND

The appellant's invention is related generally to the field of orthodontics. More particularly, the appellant's invention is related to a method and system for repositioning teeth from an initial tooth arrangement to a final tooth arrangement (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bergersen	3,950,851	Apr. 20, 1976
Kurz	4,348,178	Sept. 7, 1982
Andrews	4,591,341	May 27, 1986
Andreiko et al. (Andreiko)	5,454,717	Oct. 3, 1995
Chishti et al. (Chishti)	5,975,893	Nov. 2, 1999

Claims 1 to 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Andrews in view of Bergersen, Kurz and Andreiko.

Claims 12 to 31 and 33 to 38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Andrews in view of Bergersen and Kurz.

Claims 6 to 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Andrews in view of Kurz.

Claim 32 stands rejected under 35 U.S.C. § 103 as being unpatentable over Andrews in view of Bergersen, Kurz and Andreiko.

Claims 1 to 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Andrews in view of Chishti.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection and the answer (mailed November 29, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed October 20, 2003) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 32 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

### **The obviousness rejections utilizing Andrews and Kurz**

We will not sustain the following rejections under 35 U.S.C. § 103: (1) claims 1 to 5 and 32 as being unpatentable over Andrews in view of Bergersen, Kurz and Andreiko; (2) claims 12 to 31 and 33 to 38 as being unpatentable over Andrews in view of Bergersen and Kurz; and (3) claims 6 to 11 as being unpatentable over Andrews in view of Kurz.

In these rejections, the examiner (final rejection, pp. 2-6) first determined that Andrews teaches that it is known to use a bracket and wire system (i.e., braces) followed in series by using a mouthpiece (i.e., positioner). Next, the examiner

ascertained<sup>1</sup> that Andrews does not disclose "the use of successive appliances, other than a wire and bracket system." The examiner then determined that Kurz teaches using successive shells including intermediate appliances. Lastly, the examiner concluded that it would have been obvious to one of ordinary skill in the art to have modified Andrews to have used successive appliances as taught by Kurz in order to make use of known methods of moving teeth in series to obtain the desired results.

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require, in one manner or another, that both a wire and bracket system and a plurality of appliances be deployed in seriatim to reposition teeth from an initial tooth arrangement to a final tooth arrangement. Such a combination is not suggested by the applied prior art. In that regard, Kurz teaches (column 3, lines 22-52) that his successive appliances are used without any other orthodontic appliances to fully translate teeth from an initial malocclusion position to an ideal occlusion position. As such, Kurz teaches and suggests replacing the entire Andrews system of first using a bracket and wire system and then using a mouthpiece

---

<sup>1</sup> After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

with Kurz's successive appliances. It is our opinion, that Kurz would not have made it obvious at the time the invention was made to a person having ordinary skill in the art to have first used Andrew's bracket and wire system and then to have used Kurz's successive appliances.

In our view, the only suggestion for modifying Andrews in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 38 under 35 U.S.C. § 103 as set forth above is reversed.<sup>2</sup>

#### **The obviousness rejection utilizing Andrews and Chishti**

We will not sustain the rejection of claims 1 to 32 under 35 U.S.C. § 103 as being unpatentable over Andrews in view of Chishti.

---

<sup>2</sup> We have reviewed the references to Bergersen and Andreiko but find nothing therein which makes up for the deficiencies of Andrews and Kurz discussed above.

In this rejection, the examiner (final rejection, p. 6) first determined that Andrews teaches that it is known to use a bracket and wire system (i.e., braces) followed in series by using a mouthpiece (i.e., positioner). Next, the examiner ascertained that Andrews does not disclose "a mouthpiece made from a polymeric shell."<sup>3</sup> Chishti teaches that it is known to form mouthpieces in shells 13 from polymers and to use a plurality of shells to move teeth. Lastly, the examiner concluded that it would have been obvious to one of ordinary skill in the art to have modified Andrews to include using a plurality of successive polymeric shell as taught by Chishti in order to make use of well known mouthpiece structures for moving teeth in a desired manner.

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require, in one manner or another, that both a wire and bracket system and a plurality of appliances be deployed in seriatim to reposition teeth from an initial tooth arrangement to a final tooth arrangement. Such a combination is not suggested by the applied prior art. In that regard, Chishti teaches that his successive appliances replace braces to fully translate teeth from an initial tooth

---

<sup>3</sup> This ascertainment of the differences is incomplete and conflicts with the differences found by the examiner in the previously treated rejections. Andrews does not disclose the use of successive appliances following the use of a wire and bracket system.

arrangement to a final tooth arrangement. As such, Chishti teaches and suggests replacing the entire Andrews system of first using a bracket and wire system and then using a mouthpiece with Chishti's successive appliances. It is our opinion, that Chishti would not have made it obvious at the time the invention was made to a person having ordinary skill in the art to have first used Andrew's bracket and wire system and then to have used Chishti's successive appliances. As in the previous rejections, it is our view that the only suggestion for modifying Andrews in the manner proposed by the examiner to arrive at the claimed invention stems from impermissible hindsight knowledge derived from the appellant's own disclosure.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 32 under 35 U.S.C. § 103 as being unpatentable over Andrews in view of Chishti is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 38 under 35 U.S.C. § 103 is reversed.

REVERSED

*Charles E. Frankfort*  
CHARLES E. FRANKFORT )  
Administrative Patent Judge )  
 )  
*Jeffrey V. Nase*  
JEFFREY V. NASE ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS  
 ) AND  
 ) INTERFERENCES  
*Jennifer D. Bahr*  
JENNIFER D. BAHR )  
Administrative Patent Judge )

Appeal No. 2005-2188  
Application No. 09/751,577

Page 10

TOWNSEND AND TOWNSEND AND CREW, LLP (018563)  
TWO EMBARCADERO CENTER, EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

JVN/